



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/531,809

04/18/2005

Thierry Granier

102790-189 (30061 US)

3684

27389 7590 10/15/2008
NORRIS, MCLAUGHLIN & MARCUS
875 THIRD AVE
18TH FLOOR
NEW YORK, NY 10022

EXAMINER

NGUYEN, THUY-AI N

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,809	Applicant(s) GRANIER ET AL.	
	Examiner THUY-AI N. NGUYEN	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/11/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 is/are allowed.
- 6) ☐ Claim(s) 1,2, 10- 16, and 18-19 is/are rejected.
- 7) ☐ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's reply filed June 11, 2008 has been fully considered. Claims 1, 2, and 10-18 are amended. Claims 1, 2, and 10-18 are pending.

Claim Objections

Claim 17 is objected because the formula 1b has not been crossed corresponding to the amended claim. It would be appropriate to have the formula 1c following the statement of the compound: "a compound of formula 1c".

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, and 10- 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Freerksen et al. (Journal of Organic Chemistry, 1983, vol. 48, pages 4087-4096).

Regarding claims 1 and 2: Freerksen et al. teaches the compound 1-cyclooct-1-enylethanone (table 2, compound n, p. 4092) a compound according to formula I where X is carbonyl, R is methyl, and the double bond is between C1 and C2. While Freerksen et al. does not explicitly refer to the compounds as a fragrance, the compounds will have a vapor pressure and will inherently act as a fragrance.

Regarding claims 10-14: Freerksen et al. further teaches the compound in a solution with hexamethylphosphoramide (HMPA) (Pg. 4091, Col. 1, ¶2, Lns. 7-11). As

HMPA is a product, the teaching of Freerksen et al. satisfies Applicant's definition on Pg. 5, Lns 21-28 of Applicant's original specification of a fragrance application, as one comprising a product and an odorant (1-cyclooct-1-enylethanone).

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Dixon et al. (Journal of Chemical and Engineering Data, Vol. 20, No. 1, 1975, Pgs. 123-124).

Regarding claim 18: Dixon et al. teaches the compound 5-acetylcyclooctene (1-cyclooct-4-enylethanone), a compound of formula I, where X is a carbonyl, R is methyl, and a double bond between C4 and C5 (Pg. 123, Col. 1, ¶1, Lns.7-8).

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Dixon et al. (Journal of Chemical and Engineering Data, Vol. 20, No. 1, 1975, Pgs. 123-124).

Regarding claim 19: Dixon et al. teaches the compound 5-acetylcyclooctene (1-cyclooct-4-enylethanone) (Pg. 123, Col. 1, ¶1, Lns.7-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freerksen et al. (Journal of Organic Chemistry, 1983, vol. 48, pages 4087-4096).

Regarding claims 15- 16: Freerksen et al. teaches the method of making comprising a step for synthesis of the compound 1-cyclooct-1-enylethanone a compound according to formula I where X is carbonyl, R is methyl, and the double bond is between C1 and C2, in the presence of hexamethylphosphoramide (HMPA) (Pg. 4092, table 2, compound n, and Pg. 4091, Col. 1, ¶2, Lns. 7-11) (mixing). As HMPA is a product, the teaching of Freerksen et al. satisfies Applicant's definition on Pg. 5, Lns 21-28 of Applicant's original specification of a fragrance application, as one comprising a product and an odorant (1-cyclooct-1-enylethanone).

Allowable Subject Matter

Claim 17 would be allowable if the objection is overcome.

The following is a statement of reason for the indication of allowable subject matter:

Regarding Claim 17: The prior art does not teach a mixture of a compound of formula Ic, Ia, and Id. While Cantrell et al. (Journal of Organic Chemistry, 1971, vol. 36, Pgs. 670-676) teaches a mixture of compounds corresponding to formula Ia and Ic (Pg. 671), there is no motivation or suggestion to further add to the mixture a compound according to formula Id.

Response to Arguments

Applicant's arguments filed June 11, 2008 with regards to claims 1-2, and 10-13 have been fully considered but they are not persuasive.

Applicant argues that Freerksen et al. does not anticipate the claims as the fragrance is not inherent to the reference. However, as stated in the rejection above, while Freerksen et al. does not explicitly refer to the compounds as a fragrance, as the compounds are fragrant, they will inherently be a fragrance.

Applicant's arguments with respect to the rejection(s) of claim(s) 15 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretation of the previously applied reference (Freerksen et al.).

Applicant's arguments with respect to claims 17 have been fully considered and are persuasive. The rejection of claim 17 has been withdrawn.

The 112/101 rejections of claims 1-2 and 10-14 are withdrawn in light of Applicant's amendment.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THUY-AI N. NGUYEN whose telephone number is (571)270-3294. The examiner can normally be reached on Monday-Friday: 8:30 a.m. - 5:00 p.m. eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 8, 2008

Thuy- Ai N. Nguyen

/Mark Eashoo, Ph.D./

Supervisory Patent Examiner, Art Unit 1796